

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-42 are pending in the present application. Claims 43-105 have been canceled without prejudice or disclaimer.

The outstanding Office Action presented a rejection of Claims 1, 2, 4-10, 12-19, 21-26, 28-32, and 35-42 under 35 U.S.C. §103(a) as being unpatentable over Tomita et al. (U.S. Patent No. 6,100,884, Tomita) in view of Lawler et al. (U.S. Patent No. 5,585,838, Lawler) and a rejection of Claims 3, 11, 20, 27, 33, and 34 under 35 U.S.C. §103(a) as being unpatentable over Tomita in view of Lawler in further view of Yoshinobu et al. (U.S. Patent No. 6,100,884, Yoshinobu). The Advisory Action apparently continues reliance on all of these rejections as none are indicated to be withdrawn thereby.

As noted in the response filed September 17, 2004, the present invention is concerned with a searching system for performing a particular kind of search for contents that have been broadcast as well as a method for performing that search and a record medium having a control program for controlling that search. In each aspect of the invention, the search results are displayed along with an indicator for activation at a unit to cause downloading of the contents associated with the results of the search.

With respect to the rejection of Claims 1, 2, 4-10, 12-19, 21-26, 28-32, and 35-42 under 35 U.S.C. §103(a) as being unpatentable over Tomita in view of Lawler, it is noted that the Advisory Action indicates that all the arguments advanced in the response filed September 17, 2004, were considered but it does not adequately treat or acknowledge many of those arguments. In this regard, if the PTO is to again repeat this rejection, then it must follow MPEP §707.07(f) that requires that the substance of

each traversal made in the response filed September 17, 2004, must be answered. In order to aid the PTO's consideration of these as yet unanswered traversals, they are repeated as follows:

.... it is noted that Tomita does not, *inter alia*, teach or suggest the requirement of independent Claims 1, 18, 32, 35, and 37-42 for a display of an indicator for activation at a unit to cause downloading of broadcast contents associated with the results of a search for those contents that were broadcast, not contents associated with future broadcasts.

Tomita does not, *inter alia*, teach or suggest the requirement of independent Claims 1, 18, 32, 35, and 37-42 for a display of an indicator for activation at a unit to cause downloading of broadcast contents associated with the results of a search for those contents that were broadcast, not contents associated with future broadcasts.

Thus, the first point to be addressed in the required PTO answer to this traverse is how Tomita is being interpreted to teach "searching a list of broadcasted programs" as urged in the Advisory Action when it is clear that Tomita teaches searching a list of programs scheduled for but not yet actually broadcast.

The listing suggested by Tomita is one distributed on the internet but it is like the one published in the daily paper (see col. 1, lines 16-20) that simply lists programs scheduled for transmission on the date of publication, not programs broadcast some time in the past. Thus, as indicated at col. 5, lines 11- 20, and col. 9, lines 33-38, the "current date and time" are the starting point, not past schedules. Note col. 5, lines 42-47, that again liken the broadcast program listing to that found in a newspaper and col. 10, lines 6-9 as to listing programs the user desires to watch. See col. 11, lines 36-41 as to the results of a search being a list of TV "programs which the user desires to watch."

Accordingly, the PTO is called upon to indicate how it has determined that Tomita teaches searching a list of broadcasted programs via a graphical user interface

and providing a result of the searching” as asserted in the Advisory Action. See In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”).

Just as the PTO appears to have improperly injected its own teachings into the actual disclosure of Tomita, it has done the same as to Lawler. As noted in the response filed September 17, 2004, and repeated herein for the required PTO answer:

In this last regard, not only does Tomita not teach or suggest “an indicator for activation at the terminal unit to cause downloading of the contents associated with the search results,” neither Tomita nor Lawler suggest that the results of a search of already broadcast programs should be conducted with the search results being downloaded by activating a display indicator. Whatever else can be said as to the teachings of col. 13, line 61-col.14, line 14 and the showings of Figs. 7-9 of Lawler, it cannot be said that activation of order button 138 is to download any contents associated with search results. At best, order button is disclosed to order a pay per view event in the FUTURE, see col. 14, lines 19-21 and lines 35-38. The ordering of a “pay-per-view program or similar type program” is simply a matter of having the broadcaster process the order and then transmit the program to the subscriber’s TV set at the designated time. There is no download to the interactive time guide terminal of Lawler of the “pay-per-view” program disclosed here.

Further, it is noted that to the extent that FIG. 9 of Lawler suggests a past programs menu panel with an “order” button, this ordering is described at col. 14, lines 54-57 as done only if it can be determined that “a recording of the program is available for ordering from the head end, a far cry from any suggestion of the claimed indicator that must “cause downloading of the contents associated with the search results” as recited in Claim 1, for example. As noted in the response filed on September 17, 2004,

With further regard to the Lawler disclosure of Fig. 9 and col. 14, line 49-col. 15, line 3, the ordering of past programs is simply a request for information as to the past program availability for ordering

from the cable system (head end) as described at col. 14, lines 52-57,
not a present downloading of anything.

Thus, it is clear that no suggestion of "ordering" equaling "downloading" is to
be found in Lawler where the court requires it to be found. See In re Kotzab, 55
USPQ2d 1313, 1317 (Fed. Cir. 2000) as follows:

Specifically, there is not substantial evidence to show that "one
system" is the same thing as "one sensor." The words "sensor" and
"probe" are used throughout [the reference] to refer to the device that
measures the mold temperature. * * * [The reference] clearly never
uses the term "system" as a substitute for the simple temperature
measuring device it calls "sensor."

Just as it was the PTO that was improperly equating the terms "sensor" and "system"
in the Kotzab case, so it is the PTO that is here improperly equating the terms
"ordering" and "downloading" in violation of this established precedent. See In re
Warner, 154 USPQ 173, 178 (CCPA 1967) further noting that:

The Patent Office has the initial duty of supplying the factual basis for
its rejection. It may not, because it may doubt that the invention is
patentable, resort to speculation, unfounded assumptions or hindsight
reconstruction to supply deficiencies in its factual basis.

Accordingly, the rejection of independent Claims 1, 18, 32, 35, and 37-42 as
being obvious over Tomita in view of Lawler is again traversed as there has been no
prima facie case of obviousness established that accounts for all the limitations of
these independent claims.

Furthermore, as each of Claims 2, 4-10, and 12-17 ultimately depend from
independent Claim 1 and each of Claims 19, 21-26, and 28-31 ultimately depend from
independent Claim 18, the rejection of these dependent claims as being obvious over
Tomita is traversed for the reasons noted above as to the parent independent claims.

In addition, each of Claims 2, 5-10, 12-17, 19, 22-26, and 28-31 adds further features to its respective independent base claim and these dependent claims are further believed to patentably define over Tomita considered alone or in any proper combination with Lawler because these references fail to teach or suggest these added further features as well.

With further regard to the rejection of Claims 3, 11, 20, 27, 33, and 34 under 35 U.S.C. §103(a) as being unpatentable over Tomita in view of Lawler in further view of Yoshinobu, it is again noted that Yoshinobu cures none of the deficiencies noted above as to Tomita and Lawler. As Claims 3 and 11 ultimately depend from independent Claim 1, Claims 20 and 27 depend directly from independent Claim 18, and Claims 33 and 34 directly from independent Claim 32, the rejection of these of these dependent claims as being obvious over Tomita in view of Lawler in further view of Yoshinobu is traversed for the reasons noted above as to the parent independent claims.

In addition, each of Claims 3, 11, 20, 27, 33, and 34 adds further features to its respective independent base claim and these dependent claims are further believed to patentably define over any of Tomita and/or Lawler and/or Yoshinobu taken alone or together in any proper combination because these references fail to teach or suggest these added further features as well.

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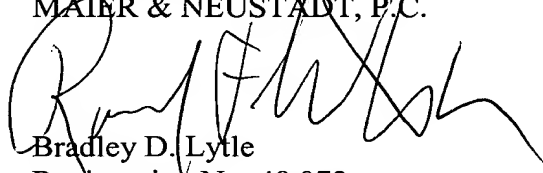
Reply to Office Action of 05/17/04 and the Advisory Action

Mailed 11/04/04

As no further issues are believed to remain outstanding in the present application, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Bradley D. Lytle', is written over the printed name and firm name.

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